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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/876,090
Filing Date: June 07, 2001
Appellant(s): BENNY ET AL.

Robert Voigt (47159)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 4, 2007 appealing from the Office action mailed 1/11/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct except for the withdrawn rejection mentioned below.

WITHDRAWN REJECTION

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claim 22 under 35 U.S.C. 101 is withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,670,973	HILL et al	12-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 23 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 23 recites a *"technical framework ... comprising steps:"*. In ¶ 46 of Appellants specification, lines 7-9 state that a *"framework"* identifies how parts fit together. In this context, *"framework"* is simply a description of entities or objects. It is nothing more than an abstract idea which is excluded from eligibility for patent protection. The claim fails to achieve a tangible and concrete result that would establish a practical application. Steps within the claim, beginning with *"a solution scope determined..."* until *"a detailed technical design developed..."*, that comprise the *"framework"*, fail to assure substantial repeatability because the *"framework"* could be something that is performed by a person. This demonstrates abstractness, and the claims are therefore rejected as not being a practical application to a judicial exception. **See MPEP Section 2106 IV.C.2.(B)(2)**

2. Claim 24 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 24 recites a *"computer program product for storage on a computer readable medium..."*. The word *"for"* infers an intended use of the *"computer*

program product", as opposed to a positively recited embodiment. In other words, the claim does not necessitate that the *"computer program product"* be physically embodied on a *"computer readable medium"*. It is therefore directed to a program per se and not to a process occurring as a result of executing the program. The claim is also not directed to a machine programmed to operate in accordance with the program, nor to a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter and is therefore nonstatutory. **See MPEP Section 2106.01 I.**

Furthermore, even if the *"computer program product"* were to be positively recited as a storage embodiment, the limitation *"storage on a computer readable medium"* is deemed to be directed to non-statutory subject matter. In ¶ 112 of Appellants specification, lines 13-15 state that the *"computer program product"* can be transmitted. Then lines 16-21 state that the act of storing instructions/program on a medium effects a physical change of that medium, where the medium may then be electrical, magnetic, etc. Based on the context presented in the specification, it is reasonable to interpret "storage on a computer readable medium" to include transmission of the "computer program product" via electrical or magnetic means, i.e. signal. This does not fall within any of the statutory categories and is therefore not patentable subject matter. **See MPEP Section 2106 IV.B.¶4 and Section 2106.01**

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/875,863.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention is directed to a method for creating a technical framework for a customer, while the pending application 09/875,863 is directed to a method for designing a technical framework for a customer. For example, Claim 22 of the instant application and claim 1 of application 09/875,863, contain limitations directed to the critical concepts of: 1. create/design a technical framework, 2. determining/identifying a solution scope, 3. mapping equipment/components into architectural building blocks, 4. listing design objects, and 5. relationships between the design objects.

For at least these reasons, it would have been obvious to one of ordinary skill in the art to determine that the at least five concepts mentioned above are common to the two applications,

and that the scope of the respective applications are not patentably distinct in so far as the specifications of each application support the identical critical features noted above.

5. Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-30 of copending Application No. 09/875,865.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention is directed to a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, while the pending application 09/875,865 is directed to a method for developing a technical framework for use in delivering System Management services for a customer. For example, Claim 22 of the instant application and claim 25 of application 09/875,863, contain limitations directed to the critical concepts of: 1. create/develop a technical framework, 2. determining/identifying a solution scope, 3. mapping equipment/components into architectural building blocks, 4. listing design objects, and 5. relationships between the design objects.

For at least these reasons, it would have been obvious to one of ordinary skill in the art to determine that the at least five concepts mentioned above are common to the two applications, and that the scope of the respective applications are not patentably distinct in so far as the specifications of each application support the identical critical features noted above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 22-25 rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al (US Patent No 6,670,973). (Note: Claim limitations are in *italics*)

Hill teaches *a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, comprising the steps of*:

determining a solution scope for the technical framework to be created (column 2 lines 62-64, Hill discloses generating a hierarchical list(s) and graph(s) (i.e. "*solution scope*") for representing elements of an information technology infrastructure (i.e. "*technical framework*") of an organization),

the solution scope guided by an information technology services contract with the customer (column 1 lines 35-51, Hill discloses that the hierarchical list(s) and graph(s) (i.e. "*solution scope*") are generated by a program designed to represent the information technology infrastructure of an organization. The user of the program is the actual organization (i.e. "*customer*") that wants its information technology infrastructure to be graphically and interactively represented by the program. Therefore, the organization (i.e. "*customer*") inherently has a service agreement to use that program (i.e. "*service contract*")),

the solution scope based on common practices for delivering certain types of information technology services (column 6 line 64 – column 7 line 8, Hill discloses that presenting the hierarchical list(s) and graph(s) (i.e. "*solution scope*"), is based on common practices such as 1. expanding and contracting each information technology element, and 2. allow scrolling if the hierarchical list is too long to be displayed in a single window);

mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model (column 9 lines 6-8 & 12-15, Hill discloses mapping information technology elements (i.e. *"customer's existing equipment"*) into levels (i.e. "*lowest level abstractions*) within a hierarchical graph (i.e. *"building blocks in a technical model"*) of an information technology infrastructure of an organization),

the technical model describing people, processes, tools and information used to deliver specific services to customers (column 4 lines 40-46 and column 6 line 64 – column 7 line 2, Hill discloses the hierarchical list (i.e. *"technical model"*) contains five levels that describe different elements and functions within an organization. It is inherent that an organization utilizes its elements and functions to deliver services to its customers),

the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities (column 4 lines 40-55 and column 6 line 64 – column 7 line 2, Hill discloses that each element is a self-contained entity that correspond to specific properties of the organization);

creating a list of design objects as a function of the solution scope for the technical framework (column 4 lines 40-46 and column 6 line 64 – column 7 line 2, Hill discloses creating a hierarchical list that contains elements of an organization (i.e. *"list of design objects"*)),

the design objects based on logical groupings of architectural building blocks, including software and hardware components (column 4 lines 40-46 and column 9 lines 5-14, Hill discloses that the elements are grouped into levels, including application, subsystem and database); and

designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer (column 3 line 59 – column 4 line 7, Hill discloses designating relationships between organizational elements and information technology elements, all within an information technology infrastructure of an organization).

8. In reference to claim 23, this is a *"technical framework"* claim that correspond to the method claim of claim 22 above. Therefore, claim 23 is rejected based upon the same rationale as given for claim 22 above.

9. In reference to claim 24, this is a *"computer program product"* claim that correspond to the method claim of claim 22 above. Therefore, claim 24 is rejected based upon the same rationale as given for claim 22 above.

10. In reference to claim 25, this is a *"data processing system"* claim that correspond to the method claim of claim 22 above. Therefore, claim 25 is rejected based upon the same rationale as given for claim 22 above.

11. The above rejections are based upon the broadest reasonable interpretation of the claims. Applicant is advised that the specified citations of the relied upon prior art, in the above rejections, are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and/or priority documents) is implied as being applied to teach the scope of the claims.

(10) Response to Argument

12. In the Appeal Brief, section "VII. A." pgs 6-11, Appellants argue that *the rejections of claims 22-24 under 35 U.S.C. 101 are in error.*

In reply, The rejection of claim 22 under 35 U.S.C. 101 has been withdrawn.

As to Claim 23: Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 23 recites a *"technical framework ... comprising steps:"*. In ¶ 46 of Appellants specification, lines 7-9 state that a *"framework"* identifies how parts fit together. In this context, *"framework"* is simply a description of entities or objects. It is nothing more than an abstract idea which is excluded from eligibility for patent protection. The claim fails to achieve a tangible and concrete result that would establish a practical application. Steps within the claim, beginning with *"a solution scope determined..."* until *"a detailed technical design developed..."*, that comprise the *"framework"*, fail to assure substantial repeatability because the *"framework"* could be something that is performed by a person. This demonstrates abstractness, and the claims are therefore rejected as not being a practical application to a judicial exception. **See MPEP Section 2106 IV.C.2.(B)(2)**

As to Claim 24: Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 24 recites a *"computer program product for storage on a computer readable medium..."*. The word *"for"* infers an intended use of the *"computer program product"*, as opposed to a positively recited embodiment. In other words, the claim does not necessitate that the *"computer program product"* be physically embodied on a *"computer readable medium"*. It is therefore directed to a program per se and not to a process occurring as a result of executing the program. The claim is also not directed to a machine

programmed to operate in accordance with the program, nor to a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It is also clearly not directed to a composition of matter and is therefore nonstatutory. **See MPEP Section 2106.01 I.**

Furthermore, even if the *"computer program product"* were to be positively recited as a storage embodiment, the limitation *"storage on a computer readable medium"* is deemed to be directed to non-statutory subject matter. In ¶ 112 of Appellants specification, lines 13-15 state that the *"computer program product"* can be transmitted. Then lines 16-21 state that the act of storing instructions/program on a medium effects a physical change of that medium, where the medium may then be electrical, magnetic, etc. Based on the context presented in the specification, it is reasonable to interpret "storage on a computer readable medium" to include transmission of the "computer program product" via electrical or magnetic means, i.e. signal. This does not fall within any of the statutory categories and is therefore not patentable subject matter. **See MPEP Section 2106 IV.B.¶4 and Section 2106.01**

13. In the Appeal Brief, section "VII. B." pgs 11-12, Appellants argue that claims 22-25 *are not properly rejected under obviousness-type double patenting.*

In reply, Examiner provisionally rejected claims 22-25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-30 of copending Application No. 09/875,865 and as being unpatentable over claims 1-15 of copending Application No. 09/875,863. The claims of the cited copending Applications contain critical concepts that are in common with the instant Application. The scope of the respective

applications are not patentably distinct in so far as the specifications of each application support the identical critical features noted in the above rejection. The double patenting rejection is maintained.

14. In the Appeal Brief section "VII. C.", last ¶ of pg 12 to first partial ¶ of pg 14, Appellants argue that Hill does not disclose "*determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contact with the customer, the solution scope based on common practices for delivering certain types of information technology services*". Appellant argues that *Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach.*

In reply, Appellants arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant has not provided an explanation of what exactly is *"a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach"*.

Despite this, an explanation of the rejection is provided: **Regarding the limitation** *"determining a solution scope for the technical framework to be created"*, see at least column 2 lines 62-64, where Hill discloses generating a hierarchical list(s) and graph(s) (i.e. "*solution scope*") for representing elements of an information technology infrastructure (i.e. "*technical framework"*) of an organization. **Regarding the limitation** *"the solution scope guided by an*

information technology services contract with the customer", see at least column 1 lines 35-51, where Hill discloses that the hierarchical list(s) and graph(s) (i.e. "*solution scope*") are generated by a program designed to represent the information technology infrastructure of an organization. The user of the program is the actual organization (i.e. *"customer"*) that wants its information technology infrastructure to be graphically and interactively represented by the program. Therefore, the organization (i.e. *"customer"*) inherently has a service agreement to use that program (i.e. *"service contract"*). **Regarding the limitation** *"the solution scope based on common practices for delivering certain types of information technology services"*, see at least column 6 line 64 – column 7 line 8, where Hill discloses that presenting the hierarchical list(s) and graph(s) (i.e. "*solution scope*"), is based on common practices such as 1. expanding and contracting each information technology element, and 2. allow scrolling if the hierarchical list is too long to be displayed in a single window.

15. In the Appeal Brief section "VII. C.", first full ¶ of pg 14 to first full ¶ of pg 15, Appellants argue that Hill does not disclose "*mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities*". Appellant argues that *Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach.*

In reply, Appellants arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically

pointing out how the language of the claims patentably distinguishes them from the references. Appellant has not provided an explanation of what exactly is *"a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach"*.

Despite this, an explanation of the rejection is provided: **Regarding the limitation** *"mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model"*, see at least column 9 lines 6-8 & 12-15, where Hill discloses mapping information technology elements (i.e. *"customer's existing equipment"*) into levels (i.e. "*lowest level abstractions*) within a hierarchical graph (i.e. *"building blocks in a technical model"*) of an information technology infrastructure of an organization. **Regarding the limitation** *"the technical model describing people, processes, tools and information used to deliver specific services to customers"*, see at least column 4 lines 40-46 and column 6 line 64 – column 7 line 2, where Hill discloses the hierarchical list (i.e. *"technical model"*) contains five levels that describe different elements and functions within an organization. It is inherent that an organization utilizes its elements and functions to deliver services to its customers. **Regarding the limitation** *"the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities"*, see at least column 4 lines 40-55 and column 6 line 64 – column 7 line 2, where Hill discloses that each element is a self-contained entity that correspond to specific properties of the organization.

16. In the Appeal Brief section "VII. C.", last partial ¶ of pg 15 to first full ¶ of pg 16, Appellants argue that Hill does not disclose "*creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of*

architectural building blocks, including software and hardware components". Appellant argues that *Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach.*

In reply, Appellants arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant has not provided an explanation of what exactly is *"a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach"*.

Despite this, an explanation of the rejection is provided: **Regarding the limitation** *"creating a list of design objects as a function of the solution scope for the technical framework"*, see at least column 4 lines 40-46 and column 6 line 64 – column 7 line 2, where Hill discloses creating a hierarchical list that contains elements of an organization (i.e. *"list of design objects"*). **Regarding the limitation** *"the design objects based on logical groupings of architectural building blocks, including software and hardware components"*, see at least column 4 lines 40-46 and column 9 lines 5-14, where Hill discloses that the elements are grouped into levels, including application, subsystem and database.

17. In the Appeal Brief section "VII. C.", last partial ¶ of pg 16 to pg 17, Appellants argue that Hill does not disclose "*designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer*". Appellant argues that *Examiner has not provided a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach.*

In reply, Appellants arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Appellant has not provided an explanation of what exactly is *"a reasonable interpretation consistent with the specification or consistent with the interpretation that those skilled in the art would reach"*.

Despite this, an explanation of the rejection is provided: **Regarding the limitation** *"designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer"*, see at least column 3 line 59 – column 4 line 7, where Hill discloses designating relationships between organizational elements and information technology elements, all within an information technology infrastructure of an organization.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ramy M Osman

February 12, 2008

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